

REMARKS

Claims 1-7 and 11-17 are all the claims pending in the application. Claim 1 has been withdrawn as being directed to a non-elected invention. Claims 8-10 have been canceled without prejudice or disclaimer. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Election/Restriction

The Examiner requested that Applicant cancel non-elected claims 1 and 8-10. Because claims 8-10 are the subject of divisional application US No. 10/425,786, Applicant has canceled these claims.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 2-7 and 11-17 under §112, 2nd paragraph, as indefinite. The Examiner noted specific instances of alleged indefiniteness in the Office Action on page 2, item 2, 2nd paragraph. Applicant has amended claim 2 so as to set forth a relationship between the feed mechanism and the cooling.

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 2-7 and 11-17 under §103(a) as being unpatentable over the alleged prior art as set forth on pages 1-3 of the present specification (hereinafter the APA) in view of US Patent 5,585,063 to Slater et al. (hereinafter Slater). Applicant respectfully traverses this rejection because there is no motivation to combine the references as suggested by the Examiner.

The Examiner asserts that the arrangement of Slater “allows for a more uniform cooling since the disks are all cooled on one cooling path and are supplied thereto by one feed

mechanism.”¹ The Examiner goes on to assert that “[o]ne of ordinary skill in this art knows that a consistent heat/cooling history for each molded disk would provide disks of more consistent optical and mechanical properties.”²

But there is no teaching or suggestion in the prior art that maintaining a consistent heat history for the disks would be desirable. Instead, it is Applicant who discloses that by alternately arranging two simultaneously molded substrates on one feed mechanism in a cooling apparatus, the substrates can be cooled without the development of a temperature difference between inner and outer circumferential regions. Further, it is Applicant who discloses that the substrates thusly cooled are “stable and free from mechanical fluctuations such as warpage and swaying, thereby producing improved characteristics of the information recording medium.”³ Therefore, the Examiner is using Applicant’s own disclosure against him. This he cannot do, because the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.⁴

Further, that each of Applicant’s claimed elements may be individually known in the art is not sufficient to render obvious Applicant’s claims. That is, the APA teaches simultaneous molding of two substrates, whereas Slater separately teaches the use of a cooling apparatus to cool a disk taken from a molding apparatus—yet Slater does not teach or suggest using one cooling apparatus to cool two substrates that have been simultaneously molded.

However, most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art.

¹ Office Action at page 3, item 4, lines 3-4.

² Office Action at page 3, item 4, lines 4-6.

³ Specification at page 24, lines 2-19.

⁴ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also *Uniroyal, Inc. v. Rudcan-Wiley, Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Id. But identification in the prior art of each individual part claimed is insufficient to defeat patentability of the claimed invention as a whole. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (*citing In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

“Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination.” *Id.* at 1073 (*citing In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

Here, there is no motivation other than that impermissibly taken directly from Applicant’s own disclosure.

For at least the above reasons, claim 2 is not rendered obvious by the APA. Likewise, dependent claims 3-7 and 11-17 are not rendered obvious by the APA. Further, Applicant respectfully traverses this rejection as it applies to claims 4, 7, and 13-15, for the following additional reasons.

With respect to claims 4, 7, and 13-15, the APA and Slater fail to teach or suggest all the elements as set forth in Applicant’s claims.

Claim 4 sets forth supporting the injection molded substrates vertically on a feed screw mechanism. Claim 7 sets forth supporting the injection molded substrates on a rotatable polygonal prism with outer facets thereof attracting the substrates, respectively. Neither one of these elements is taught or suggested by the Examiner’s attempted combination of the APA and Slater. In contrast to that set forth in claims 4 and 7, the APA discloses the use of rotary tables having chucks for holding the substrates at central holes thereof, or being arranged vertically in a

magazine.⁵ Further, again in contrast to that set forth in claims 4 and 7, Slater teaches holding substrates vertically in a rotary magazine (see Figs. 2 and 5), vertically in a carrier box or frame 130 (Fig. 9), vertically on a conveyor chain or belt to which there are mounted holders 142 that engage the substrates D at their center holes (Fig. 10), or by a vertically oriented turret 144 provided with a plurality of holders 146 that support the substrates D at their center holes. Accordingly, for the sake of argument, even assuming that one of ordinary skill in the art were motivated to combine the APA and Slater as suggested by the Examiner, any such combination would still not include the elements as set forth in Applicant's claims 4 and 7.

Claims 13 and 14 set forth that alternately arranging comprises alternately arranging two substrates at a pitch which is at least 8 times the thickness of each of the substrates.

The Examiner, citing to col. 4, line 62, asserts that Slater teaches a pitch of 6-8+ times the thickness of the substrates. The Examiner's interpretation of Slater is mistaken. In col. 4, on lines 60-64, Slater teaches "a clearance between adjacent substrates in the range of 0.12 to 0.35 inch". However, Slater then teaches that the thickness of the substrates is "about 0.050 inch".⁶ Accordingly, a pitch of at least 8 times the thickness of Slater's substrate is 0.40 inch, which is larger than Slater's largest disclosed pitch of 0.35 inch. Therefore, Slater fails to teach or suggest arranging two substrates at a pitch which is at least 8 times the thickness of each of the substrates, as set forth in claims 13 and 14.

Claim 15 sets forth cooling two substrates, wherein the cooling comprises intermittently feeding the two substrates by a feed mechanism at an interval ranging from 1 second to 60 seconds.

The APA is silent as to whether the substrates are intermittently fed, and accordingly does not teach or suggest any particular interval between feeding, let alone one ranging from 1 second to 60 seconds as set forth in claim 15. Further, although Slater teaches that the substrates

⁵ Specification at page 2, lines 17-23.

⁶ Slater at col. 5, lines 56-63.

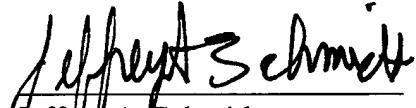
are intermittently fed, it does not teach or suggest any particular interval at which they are so fed, let alone one ranging from 1 second to 60 seconds, as set forth in claim 15. Accordingly, even assuming that one of ordinary skill in the art were motivated to combine the APA and Slater as suggested by the Examiner, any such combination would still not teach or suggest intermittently feeding substrates at an interval of 1 second to 60 seconds, as set forth in claim 15.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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